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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,196	10/20/2003	Triveni P. Shukla	00030-001	4429

7590

10/29/2004

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EXAMINER

DONOVAN, MAUREEN C

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/689,196	Applicant(s) SHUKLA ET AL.	
	Examiner Maureen C Donovan	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 4-6 are objected to because of the following informalities: The first letter of the first word of each claim should be capitalized. Appropriate correction is required.

1. Claims 4-6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims list no other elements of the food that comprises the ice cream, yogurt or ice milk, to differ the food from the ice cream, yogurt or ice milk and therefore does not further limit the claims from which they are dependent upon.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Baer, US patent number 5 011 701.

Baer discloses food products containing an aqueous dispersion comprised of a dietary fiber gel, water and lipid. Baer discloses that the food products are fat-free food compositions such as frozen desserts, which have smooth, and creamy oil-like textures and well rounded fat mimetic mouthfeel characteristics, such as ice cream or other frozen desserts with milk fat (see Column 2, lines 29-41 and Column 14, lines 5-55). Note that the Office interprets the reference to disclose ice cream, ice milk and frozen yogurt with the disclosure of frozen desserts containing milk fat. With regard to claims 4-6: the instant claims have recited no additional elements of the food that comprises the ice cream, frozen yogurt or ice milk and therefore the claims can read solely on those products alone, and those products alone have been shown to be disclosed by Baer above.

Baer discloses the use of microcrystalline cellulose (see Column 4, lines 31-33), which is a source of dietary fiber and is a gel in water, therefore is a dietary fiber gel. Baer discloses the use of a lipid with the dietary fiber gel (see Column 12, lines 43-63). Baer discloses adding the dietary fiber and lipid to water to form an aqueous dispersion (see Column 21, Example 5, lines 18-47) and then adding that aqueous dispersion to a food product as a fat replacement (see Column 2, lines 9-11 and 29-41 and see Column 20, Example 4). The aqueous dispersion as disclosed by Baer comprises a dietary fiber gel, water and lipid; thus, it is the same as the emulsified liquid shortening composition, even though such term is not used in the reference. Baer discloses that the solids contained within the dietary fiber gel represent from about 0.25-4% by weight of the

Art Unit: 1761

overall food formulation (see Column 14, lines 66-68 and Column 15, lines 1-2), which encompasses the weight ranges as instantly claimed for each food formulation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 4-6 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Baer as applied to claims 1-3 above, and further in view of Forkner, US patent number 4 171 380.

Baer discloses all of the features of the instantly claimed invention except for a food product comprising the frozen dessert food.

Forkner teaches the use of a frozen dessert filling in a cookie dough envelope, wherein the frozen dessert can be ice cream, ice milk and frozen yogurt (see Abstract and Column 7, lines 25-28). It would have been obvious to one of ordinary skill in the art

at the time of the invention to put the frozen dessert formulations as disclosed by Baer into the food product as taught by Forkner since both are directed to frozen dessert products, since it would have been obvious to look at the Forkner reference for one of ordinary skill in the art that was looking to existing art resources to find examples of uses for frozen desserts and since using the frozen dessert formulations of Baer in the product of Forkner would provide an interesting and marketable way of manufacturing and selling the dessert formulations of Baer.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 10/689267.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim the same emulsified liquid shortening composition in similar type food products that are not patentably distinct, in that dressings and ice

Art Unit: 1761

creams are both food products that are characterized by smooth, creamy oil like textures, that are viscous and fat containing; and both applications claim overlapping weight percentages that the emulsified liquid shortening is present in the foodstuffs.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McGinley et al, US patent 5 192 569, discloses an aqueous dispersion comprising dietary fiber gel, water and lipid.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen C Donovan whose telephone number is (571) 272-2739. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCD


KEITH HENDRICKS
PRIMARY EXAMINER